

## **REMARKS**

Entry of the previous amendments is respectfully requested. Claims 1, 13, and 21 have been amended. Claims 12 and 18-20 have been cancelled. Claims 1-11, 13-17, and 21 are currently pending in the application. Favorable reconsideration and allowances are respectfully requested in light of the foregoing amendments and the following remarks.

### **1. Claim Rejections Under 35 U.S.C. §102**

#### Claims 1-5, 9, 10, 12-14, 16, 17, and 20

In the Office Action, the Examiner has rejected claims 1-5, 9, 10, 12-14, 16, 17, and 20 under 35 U.S.C. §102(b) as being anticipated by Clark et al., U.S. Reissue Patent No. RE 24,554 (the ‘554 patent).

Applicant respectfully traverses the Examiner’s rejections to claims 1-5, 9, 10, 12-14, 16, 17, and 20 based on the ‘544 patent. More specifically, with this response, Applicant has amended claim 1 to specify that the method consists essentially of the steps of providing the substrate, applying a colorant to the substrate, and applying an overcoat to the substrate over the colorant. In addition, the overcoat is specified as consisting essentially of an elastomer thereby preventing any colorant from being present in the overcoat. Thus, only a single colorant is applied to the substrate in the method of claim 1.

Conversely, the ‘554 patent discloses a heat-sensitive copying-paper in which an undercoat having a specific color is applied to a paper beneath a non-transparent heat-sensitive layer including a pigment that is activated when heated. Thus, the ‘554 patent discloses a paper having two separate colorants supplied to the substrate, which is expressly excluded from the scope of amended claim 1.

As a result, the subject matter of claim 1 is not shown or described in the ‘544 patent, such that claim 1 is allowable. Further, based on their dependency from claim 1, claims 2-5, 9, 10, 13-14, 16, and 17 are also allowable, and respectfully requests that the Examiner withdraw her rejections to these claims.

### **2. Claim Rejections Under 35 U.S.C. §103**

#### A) Claims 11 and 15

In the Office Action, the Examiner has rejected claims 11 and 15 under 35 U.S.C. §103(a) as being unpatentable over the ‘554 patent.

Applicant respectfully traverses the Examiner's rejections of claims 11 and 15 based on the '554 patent. More specifically, as discussed previously regarding the rejection of claim 1 in light of the '554 patent, the subject matter of claim 1 is neither shown nor described by the '554 patent, and is therefore allowable. Because claims 11 and 15 depend from claim 1, and therefore incorporate all of the limitations of claim 1, that claims 11 and 15 are also allowable. Applicant therefore respectfully requests that the Examiner withdraw her rejections to claims 11 and 15.

B) Claims 1-3 and 5-8

In the Office Action, the Examiner has rejected claims 1-3, 5-8, and 20 under 35 U.S.C. §103(a) as being unpatentable over European Patent Application No. 1,176,255 (the '255 reference).

Applicant respectfully traverses the Examiner's rejections of claims 1-3 and 5-8 based on the '255 reference. More specifically, as stated previously with this response, Applicant has amended claim 1 to specify that the method is limited to the steps of providing the substrate, applying the colorant to the substrate, and applying the overcoat to the substrate over the colorant. Further, the overcoat as claimed in claim 1 consists essentially of an elastomer, which is subject matter taken from cancelled claim 12 which previously depended from claim 1.

Conversely, the '255 reference does not disclose a method of coloring a substrate including the step of applying an overcoat consisting essentially of an elastomer as required by the method of claim 1. As a result, the subject matter of claim 1 is neither shown nor described by the '255 reference, such that claim 1 is allowable. Further, based on their dependency from claim 1, claims 2, 3, and 5-8 are also allowable, and Applicant respectfully requests the Examiner withdraw the rejection to these claims.

**3. Claim Rejections Under 35 U.S.C. §112**

In the Office Action, the Examiner has rejected claims 1-17, 20 and 21 under 35 U.S.C. §112, first paragraph, as including new matter.

Applicant respectfully traverses the Examiner's rejection of claims 1-17, 20, and 21 under 35 U.S.C. §112, first paragraph. More specifically, with this response, Applicant has amended claim 1 to remove the limitation "non-white" objected to by the Examiner, and has cancelled claim 20. As a result, Applicant respectfully requests that the Examiner withdraw her rejections to claims 1-17, 20 and 21.

### CONCLUSION

It is submitted that claims 1-11, 13-17, and 21 are in compliance with 35 U.S.C. §§112, 102, and 103 and each defines patentable subject matter. A Notice of Allowance is therefore respectfully requested.

No fees are believed to be payable with this communication; nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to charge any fee or credit any overpayment to Deposit Account No. 50-1170.

In view of the foregoing amendments and remarks, the application is believed to be in prima facie condition for allowance, and such action is respectfully requested. The Examiner is invited to contact the undersigned if it would help expedite the prosecution and allowance of this application.

Respectively submitted,



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Dated: 9/11/06

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